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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re China Healthways Institute, Inc. dba CHI Institute

Serial No. 76361091

Darren S. Rimer of Rimer & Mathewson LLP for China Healthways Institute, Inc. dba CHI Institute.

Verna Beth Ririe, Trademark Examining Attorney, Law Office 105 (Thomas G. Howell, Managing Attorney).

Before Hanak, Holtzman and Rogers, Administrative Trademark Judges.

Opinion by Holtzman, Administrative Trademark Judge:

China Healthways Institute, Inc. dba CHI Institute has appealed from the final refusal of the trademark examining attorney to register the mark shown below for the following goods (as amended): "Newsletters in the field of health, human wellness and vitality, but specifically excluding the field of hospice care," in International Class 16.¹

¹ Application Serial No. 76361091, filed January 22, 2002, based on an allegation of first use and first use in commerce in May 1993.



The application includes an English translation of "Chi" as "vital energy force thought to be inherent in all things."

The trademark examining attorney has refused registration under Section 2(d) of the Trademark Act on the ground that applicant's mark, when applied to applicant's goods, so resembles the mark CHI for the goods and services identified below as to be likely to cause confusion.²

Newsletters in the field of hospice care for children.
Class 16.

Charitable fund raising. Class 36.

Development and dissemination of educational materials of others in the field of hospice care for children. Class 41.

When the refusal was made final, applicant appealed. Briefs have been filed. An oral hearing was not requested.

Here, as in any likelihood of confusion analysis, we look to the factors set forth in *In re E. I. du Pont de Nemours & Co.*,

Applicant originally applied for registration in two additional classes of goods, Class 10 for "electric massage apparatus for therapeutic use, and accessories therefor" (as amended), and Class 11 for "air purifying units and ionizers for commercial and domestic use." Class 10 was subsequently divided out of this application (on March 4, 2003). It is clear from the record that the refusal to register in the present application pertains to Class 16 only.

² Registration No. 2023750 issued December 17, 1996; Section 8 and 15 affidavits accepted and acknowledged, respectively.

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476 F.2d 1357, 177 USPQ 563 (CCPA 1973), giving particular attention to the factors most relevant to the case at hand, including the similarity of the marks and the similarity of the goods. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

Turning first to the marks, applicant's mark, CHI and design, and registrant's mark, CHI, in typed form, are identical in sound. The marks are also identical in meaning. Applicant states that CHI in English means "vital energy force thought to be inherent in all things." That same meaning applies to registrant's mark. The design element of applicant's mark results only in a modest visual difference in the marks which is not sufficient to differentiate one mark from another and does not change the meaning or commercial impression both marks create. If anything, the design element serves to reinforce the impression of "energy" conveyed by the term "CHI" alone.

As our primary reviewing Court has stated, the identity of words, connotation, and commercial impression weighs heavily against the applicant. See *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993) citing *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289, 1289-90 (Fed. Cir. 1984). It is clear that these highly similar marks, if used in connection with related goods, would be likely to cause confusion. We turn then to a consideration of the goods.

The examining attorney argues that applicant's goods are in part identical to the goods offered by registrant in that newsletters in the field of hospice care would necessarily provide information in the field of health. The examining attorney contends that registrant's newsletters would include the same type of information presented in applicant's newsletters and that consumers would expect to see information about health in a newsletter about hospice care. In addition, the examining attorney has submitted a dictionary definition of "hospice" as "a place or organization that provides care to people that are dying," and copies of third-party registrations covering both hospice care and other health care and wellness services to show that the subject matter of the respective newsletters would be perceived by consumers as likely to emanate from a common source.

It is well settled that goods need not be identical or even competitive to support a finding of likelihood of confusion. See *Helene Curtis Industries Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618 (TTAB 1989). It is sufficient if the respective goods are related in some manner and/or that the conditions surrounding their marketing are such that they would be encountered by the same persons under circumstances that could, because of the similarity of the marks used thereon, give rise to the mistaken belief that they emanate from or are associated with, the same

source. See In re Albert Trostel & Sons Co., 29 USPQ2d 1783 (TTAB 1993).

Registrant's newsletters in the field of hospice care for children are very closely related to applicant's newsletters which include information about health matters in general. Applicant contends that the respective newsletters are offered in different fields. In this regard, applicant has compared printouts of pages from registrant's website with the actual content of its own newsletters³ and moreover points out that applicant has specifically excluded the field of hospice care from its identification of goods.

Even with the exclusion, the topics covered by applicant's newsletter still overlap with, or are at least very similar to, the topics covered by registrant's newsletter. Applicant's newsletters deal with all matters relating to health, which would include children's health. Registrant's newsletters covering hospice care for children would necessarily include matters relating to children's health. This is confirmed by registrant's website materials stating that "CHI is committed to the concept of care called 'hospice.' It recognizes the right and need for children and their families to choose health care and support

³ This evidence was properly made of record by applicant prior to appeal. However, the examining attorney has properly objected to additional materials submitted with applicant's brief as untimely, and such materials have been given no consideration.

whether in their own home, hospital, or hospice care facility." In addition, the third-party registrations submitted by the examining attorney showing that the marks have been registered for both healthcare services and hospice services provide further evidence that the respective newsletters would be perceived by consumers as emanating from the same source. See *In re Albert Trostel & Sons Co.*, *supra*.

Applicant argues that the actual focus of its newsletters is on the benefits of using applicant's therapeutic massager that is offered for sale under its mark, and that the newsletters are "likely" to be marketed to entirely different classes of consumers. In particular, applicant maintains that its own newsletters are directed to the adult population interested in alternative health and "increasing their overall well being and vitality in life," whereas registrant's newsletters are "likely targeted" to hospitals and other organizations interested in promoting the health of children.

The question of likelihood of confusion is based on the goods as identified in the application and registration regardless of what applicant may claim, or the record may show, as to the actual content of the newsletters or the intended audience. See *CBS, Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198 (Fed. Cir. 1983). Apart from the exclusion of hospice care in applicant's identification of goods, there is otherwise no

limitation as to content, channels of trade or classes of purchasers in applicant's identification of goods. Therefore, we must assume that applicant's newsletters would cover all health topics, including topics relating to children's health other than hospice care, and that the newsletters would reach all the usual classes of purchasers, including the ordinary purchasers and healthcare professionals who may subscribe to or read registrant's newsletters. Registrant's website materials and applicant's newsletter show that, indeed, healthcare providers are among the intended customers for both goods. Thus, the purchasers are not only legally identical but identical in fact.

Because the marks are so similar, purchasers would naturally assume that applicant's and registrant's newsletters covering closely related, if not overlapping, children's health issues come from the same source, or that there is otherwise some affiliation or connection between them.

Decision: The refusal to register as to Class 16 is affirmed.⁴ The application file will be forwarded to the Office of the Commissioner for Trademarks for appropriate action with respect to Class 11.⁵

⁴ Applicant's proposed amendment to Section 2(f) is neither timely nor relevant and has been given no consideration.

⁵ We note that two third-party objections to registration have been filed in this application, one on March 5, 2003 and the other on February 20, 2004. The Board acknowledged the latter in an action mailed September 9, 2004. These objections have had no bearing on our

decision herein. However, because Class 11 was not the subject of the examining attorney's refusal, and since this application would otherwise proceed to registration in that class, the application is being forwarded to the Office of the Commissioner for Trademarks for consideration of the third-party objections as they pertain to Class 11 (and/or divided out Class 10, if appropriate). Applicant should note that the time for appeal of the decision with respect to Class 16 runs from the mailing date of this opinion.